

REMARKS

By this amendment, claims 1-6, 8-13 and 16-20 are pending, in which claims 1, 8, 16 and 17 are currently amended. These changes are not believed to raise new issues requiring further consideration and/or search, and it is therefore respectfully requested that the present amendment be entered under 37 C.F.R. §1.116. No new matter is introduced.

The Final Office Action dated March 8, 2011, **A)** rejected claims 1-7, 13 and 16-20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; **B)** rejected claims 1-4 and 6 as obvious under 35 U.S.C. § 103(a) based on *Pelaez et al.* (US 2003/0147373) in view of *Hymel* (US 2003/0216137) and *Castell et al.* (US 7,283,808); and **C)** rejected claims 5, 7 and 18-20 as obvious under 35 U.S.C. § 103(a) based on *Pelaez* in view of *Hymel* and *Castell* and further in view of an Official Notice. Applicant traverses the rejections as discussed below.

A. 35 U.S.C. § 112, First Paragraph, Rejection of Claims 1-7, 13 and 16-20

With respect to the rejection of claims 1-7, 13 and 16-20 under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement, Applicant respectfully traverses the rejection for at least the reasons presented below.

The Office Action alleged that the recitation, "a voicemail box associated with the telephone number," as recited in claims 1, 8, 16 and 17, is not described in the specification. Office Action, page 2. Initially, Applicant stresses the requirements under 35 U.S.C. § 112, first paragraph.

The analysis of whether the specification complies with the written description requirement calls for the Examiner to compare the scope of the claim with the scope of the description to determine whether Applicant has demonstrated possession of the claimed

invention. M.P.E.P. § 2163. Such a review is conducted from the standpoint of one of skill in the art at the time the application was filed and should include a determination of the field of the invention and the level of skill and knowledge in the art. *See, e.g., Wang Labs. v. Toshiba Corp.*, 993 F.2d 858, 865, 26 USPQ2d 1767, 1774 (Fed. Cir. 1993). Importantly, the subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. M.P.E.P. § 2163.02. Thus, literal support is not required by the statute. *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 923 (Fed. Cir. 2004). Applicant need not utilize any particular form of disclosure to describe the subject matter claimed; the description need only allow persons of ordinary skill in the art to recognize that he or she invented what is claimed. *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008) (quoting *In re Alton*, 76 F.3d 1168, 1172 (Fed. Cir. 1996)).

In view of the foregoing, one of ordinary skill in the art would understand that a voice mail box is inherently associated with a telephone number. The specification repeatedly discusses a voice mail box, and thus, inherently provides support for, "a voice mail box associated with the telephone number," as recited in claims 1, 8, 16 and 17.

Further, the specification discusses that a call is made between a caller's device and a receiving device. P2/L11-12. The receiving device is identified by a certain telephone number. P2/L12-13. If a connection cannot be made between the caller's device and the receiving device, the caller can record a voice message as a multimedia message. P2/L22-24. In the case where the receiver's device cannot process the message delivered in, for example, MMS form, the message can be transmitted from a messaging service receiving the receiver's message further to the receiver's voice mail box. P2/L34-P3/L2. Accordingly, the written description explicitly describes the claimed subject matter in such a way as to reasonably convey

to one skilled in the relevant art that Applicant, at the time the application was filed, was in possession of the claimed subject matter.

The Office Action further alleged that the recitation, "the multimedia message includes an identifier to indicate that the multimedia message is created as a response to a failed attempt," as recited in claim 2, is not described in the specification. Office Action, page 2.

Applicant directs the Examiner's attention to page 5 of the specification, which recites, "the operator can recognize a multimedia message according to the invention from a regular message by means of an identifier included in the message, said identifier indicating that said message is produced automatically after a failed attempt of establishing a connection." P5/L16-19 (emphasis added). Accordingly, the written description explicitly describes the claimed subject matter in such a way as to reasonably convey to one skilled in the relevant art that Applicant, at the time the application was filed, was in possession of the claimed subject matter.

The Office Action further alleged that the recitation, "wherein the multimedia message is converted by a messaging server to a voicemail for delivery to the voice mail box," as recited in claims 18 and 19, is not described in the specification. Office Action, pages 2 and 3. Applicant directs the Examiner's attention to pages 2 and 3 of the specification, as discussed above, which recites, "[i]n case the receiver's device cannot process a sound clip delivered in MMS form, the produced sound clip can be transmitted from a messaging service receiving the receiver's messages further to the receiver's voicemail box." P2/L34-P3/L2. Accordingly, the written description explicitly describes the claimed subject matter in such a way as to reasonably convey to one skilled in the relevant art that Applicant, at the time the application was filed, was in possession of the claimed subject matter.

The Office Action further alleged that the recitation, "wherein the multimedia message is forwarded to a web page associated with the receiver," as recited in claim 20, is not described in

the specification. Office Action, page 3. Applicant directs the Examiner's attention to page 5 of the specification, which recites, "[r]egular multimedia messages . . . can be directed from the messaging server for example to a given www page [web page], in case the device defined as the receiver is not capable of receiving them." P5/L28-31. Further, it is inherent that the web page is associated with the receiver by, for example, both being associated with the intended recipient of the message, such that the message can reach the intended recipient. Accordingly, the written description explicitly describes the claimed subject matter in such a way as to reasonably convey to one skilled in the relevant art that Applicant, at the time the application was filed, was in possession of the claimed subject matter.

Based on the foregoing, withdrawal of the rejection is respectfully requested.

B. 35 U.S.C. § 103(a) Rejection of Claims 1-4 and 6

With respect to the rejection of claims 1-4 and 6 (and presumably claims 8, 10, 11, 13, 16 and 17) as obvious under 35 U.S.C. § 103(a) based on *Pelaez* in view of *Hymel* and *Castell*, Applicant respectfully traverses the rejection for at least the reasons presented below.

Initially, the rationale provided in the Office Action appears to be nothing more than an agglomeration of bits and pieces of the claimed subject matter thrown together through the exercise of impermissible hindsight reasoning, without any of the articulated reasoning and rational underpinnings required by the U.S. Supreme Court. See *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007). Thus, no *prima facie* case of obviousness has been established. For at least this reason, this rejection must be withdrawn. However, for the purpose of expediting prosecution to allowance, the rejection also must be withdrawn for at least the following reason.

Pelaez in view of *Hymel* and *Castell* would not have rendered obvious the combination of features recited in independent claims 1, 8, 16 and 17, including the variously recited feature, "determining to transmit the multimedia message to a voice mail box associated with the telephone number."

The Office Action acknowledged that *Pelaez* fails to teach a voice mail box associated with a telephone number. Office Action, page 5. The Office Action alleged that *Castell* cures *Pelaez* deficiency because *Castell* allegedly teaches a voice mail box associated with a telephone number in order for call receiving devices to obtain messages stored for them. Office Action, page 5. Thus, the Office Action merely alleged that *Castell* discloses the concept of a voicemail box. The Office Action failed to address that the above recited feature of independent claims 1, 8, 16 and 17 recites, "transmit the multimedia message to a voicemail box" and either one or both of *Pelaez* with *Castell* fails to teach this feature.

Importantly, *Pelaez* discloses that a multimedia mail message is stored at a multimedia-based answering system 200. *Pelaez*, paragraph [0026]. One of ordinary skill in the relevant art would not consider that the multimedia-based answering system 200 constitutes a voicemail box. Nor would one of ordinary skill in the art consider that a multimedia mail message constitutes a voice mail. *Castell* merely discloses a voice mail box that stores voice mails. *Castell*, C4/L55-C5/L9.

The Office Action presumably alleged that it would have been obvious to one of ordinary skill in the art to replace *Pelaez's* multimedia-based answer system 200 with the voicemail box disclosed in *Castell*. However, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In this case, modifying *Pelaez's* system would cause the system to be inoperable for its

intended purpose. Specifically, storing multimedia signals in conventional voice mail systems would cause technical compatibility issues because a traditional voice mail system cannot receive multimedia signals as voice mails. Thus, because the proposed modification would render *Pelaez's* system inoperable, there is no suggestion or motivation to make the proposed modification as alleged in the Office Action. Because *Hymel* fails to cure the deficiency of *Pelaez* and *Castell*, the rejection is improper.

Thus, claims 1, 8, 16 and 17 are patentable over *Pelaez* in view of *Hymel* and *Castell*. Claims 2-4, 6, 10, 11 and 13 also are patentable over *Pelaez* in view of *Hymel* and *Castell*, for at least the same reasons as claims 1 and 8, from which the claims depends, as well as for the additional features the claims recite.

Accordingly, withdrawal of the rejection is respectfully requested.

C. 35 U.S.C. § 103(a) Rejection of claims 5, 7 and 18-20

The rejection of claim 7 is moot because the claim was previously canceled. With respect to rejection of claims 5 and 18-20 (and presumably claims 9 and 12) as obvious under 35 U.S.C. § 103(a) based on *Pelaez* in view of *Hymel* and *Castell* and further in view of an Official Notice, Applicant respectfully traverses the rejection.

Applicant reiterates that the rationale provided in the Office Action appears to be nothing more than an agglomeration of bits and pieces of the claimed subject matter thrown together through the exercise of impermissible hindsight reasoning, without any of the articulated reasoning and rational underpinnings required by the U.S. Supreme Court. See *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007).

Further, the Office Action alleged that claim 9 would have been obvious over the cited art without providing any discussion whatsoever regarding the features recited in the claim.

Specifically, claim 9 recites, "wherein the multimedia message includes an identifier indicating that the multimedia message was created automatically," which no other dependent claim variously recites. Thus, the rejection of claim 9 cannot be based on a rejection of any other dependent claim, which the Office Action has improperly alleged to support the rejection.

For at least these reasons, no *prima facie* case of obviousness has been established, and this rejection must be withdrawn. However, for the purpose of expediting prosecution to allowance, the rejection also must be withdrawn for at least the following reason.

Although the Examiner may in some instances take official notice of certain facts to fill in the gaps, such facts should not comprise the principle evidence upon which a rejection is based. See *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 42021 (CCPA 1970). Particularly for claims 18-20, the entirety of the rejection relies on facts taken as official notice. Pursuant to MPEP § 2144.03, Applicant again respectfully traverses the Official Notice and requests the Examiner to produce references showing the claimed features or withdraw the rejection as factually inadequate.

Moreover, the Official Notice fails to overcome the deficiencies set forth above with respect to *Pelaez* in view of *Hymel* and *Castell*. Therefore, dependent claims 5 and 18-20 (and presumably claims 9 and 12) also are patentable for at least the same reasons independent claim 1 is patentable, from which they variously depend, as well as for the additional features these claims recite.

Accordingly, withdrawal of the rejection is respectfully requested.

Conclusion

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any

unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9952 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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